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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,558	06/13/2001	Tomoyuki Asano	09792909-5109	7084

  

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EXAMINER	
NGUYEN, NGA B	

  

ART UNIT	PAPER NUMBER
3692	

  

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/880,558	<b>Applicant(s)</b> ASANO, TOMOYUKI	
	<b>Examiner</b> Nga B. Nguyen	<b>Art Unit</b> 3692	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 August 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17, 18 and 20-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17, 18 and 20-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Office Action is the answer to the Amendment filed on August 8, 2007, which paper has been placed of record in the file.
2. Claims 17, 18, and 20-27 are pending in this application.

### ***Response to Arguments/Amendment***

3. Applicant's arguments with respect to claims 17, 18, and 20-27 have been considered and moot in view of new ground of rejection.
4. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 17, 18, and 20-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spies, U.S. Patent No. 6, 055, 314, in view of Pitroda, U.S. Patent No. 5,884,271.

Regarding to claim 17, Spies discloses a method for providing a fee for a service of a service provider comprising the steps of:

receiving a service request requesting desired service for a user from the service provider and a digital signature created based on said service request to said service provider (column 6, line 35-column 7, line 67, the purchaser 26 inserts the IC card 50 into the purchaser's computing unit, the IC card 50 encrypts the purchaser order and attached the digital signature to the order; the order then sent to the merchant);

automatically recording the service request and the digital signature in an IC card (column 7, lines 1-67, the IC card 50 stores two asymmetric key pairs; the IC card computes the hash of the order; the IC card encrypts the order and attached the digital signature to the order; column 8, lines 25-47, the package 56 contains policy and program key, is transmitted to the IC card);

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receiving the IC card from the user to determine whether said service request and said digital signature are valid and when it is determined that said service request and said digital signature are valid, collecting the fee from the user (column 7, line 60-column 8, line 57, the merchant receives the IC card from the purchaser and decrypts the order; column 15, lines 43-67, e.g. the head end server debits the subscriber billing account according to the payment instruction).

Spies does not disclose wherein information recorded on the IC card cannot be modified. However, Pitroda discloses wherein information recorded on the IC card cannot be modified (column 11, lines 58-62, the UET card contains a 32 bit-non erasable unique number 401 assigned to each UET card for security; and column 14, lines 1-18, the signature is stored in a memory location from which it can not be erased by the user). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Spies to adopt the feature taught by Pitroda above, for the purpose of enhancing the security for the confidential information stored in the IC card.

Regarding to claim 18, Spies further discloses wherein said IC card is connectable to said user terminal, and the user sends said service request and said digital signature stored in said IC card by submitting said IC card (column 6, line 35-column 7, line 67, the purchaser 26 inserts the IC card 50 into the purchaser's computing unit, the IC card 50 encrypts the purchaser order and attached the digital signature to the order; the order then sent to the merchant).

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Regarding to claim 20, Spies does not disclose wherein said service request and digital signature stored in said IC card are impossible for the user to rewrite. However, Pitroda discloses wherein said service request and digital signature stored in said IC card are impossible for the user to rewrite (column 14, lines 1-18, the signature is stored in a memory location from which it can not be erased by the user). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Spies to adopt the feature taught by Pitroda above, for the purpose of enhancing the security for the confidential information stored in the IC card.

Regarding to claim 21, Spies further discloses wherein said IC card has information used for generating said digital signature (column 7, lines 1-67).

Regarding to claims 22-23, Spies does not disclose wherein said information includes the personal information of the user, discloses wherein said personal information includes a user name and a bank account number of user. However, Pitroda discloses wherein said information includes the personal information of the user, discloses wherein said personal information includes a user name and a bank account number of user (column 2, lines 45-60, the UET card is capable of storing personal information such as the card owner's name, address, date of birth, signature, credit card company account numbers, etc.). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Spies to adopt the feature taught by Pitroda above, for the purpose of providing more convenient for submitting purchaser's information.

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Claims 24-25 are written in means and contain similar limitations found in claim 17-18 above, therefore, are rejected by the same rationale.

Regarding to claim 26, Spies discloses a system for requesting service of a service provider comprising:

a user terminal for providing to a service provider a service request requesting desired service and a digital signature created based on said service request to said service provider (column 6, lines 35-55, purchaser's computing unit); and

a storage medium for storing said service request and said digital signature (column 7, lines 1-67, the IC card 50 stores two asymmetric key pairs; the IC card computes the hash of the order; the IC card encrypts the order and attached the digital signature to the order; column 8, lines 25-47, the package 56 contains policy and program key, is transmitted to the IC card), and

an accounting terminal determines whether said service request and said digital signature are valid before collecting a fee from the user terminal (column 6, lines 35-55, the merchant computing unit 44).

Spies does not disclose wherein when the user objects to a charge, in response to a charge collection notice from an accounting terminal, the user enables a sending of a data stored in said storage medium to said accounting terminal. However, Pitroda discloses through the user of UET card, a substantial amount to such paperwork can be eliminated and transactions with the service companies can be conducted simultaneously in real time **to resolve disputes** and can be recorded electronically (column 18, lines 3-15), the UET card may be configured with sufficient memory to store

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all transactions electronically, so as to eliminate or reduce the need for paper receipts (column 11, lines 4-6), the UET card is capable of sending of a data stored in storage medium to the accounting terminal (column 10, lines 25-33). Moreover, it is well known in the art that when the user objects to a charge, the user often submits the transaction receipt to the accounting terminal. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Spies to adopt the feature taught by Pitroda and the well-known feature above, to enable the user sending of a data stored in said storage medium to said accounting terminal when the user objects to a charge, for the purpose of providing more convenient to the user when requesting a dispute transaction, because the user does not need to keep a paper copy of receipt which may be easily lost.

Regarding to claim 27, Spies discloses further wherein said IC card is connectable to said user terminal, and the user sends said data stored in said IC card by submitting said IC card (column 6, line 35-column 7, line 67, the purchaser 26 inserts the IC card 50 into the purchaser's computing unit, the IC card 50 encrypts the purchaser order and attached the digital signature to the order; the order then sent to the merchant).

### ***Conclusion***

7. Claims 17, 18, and 20-27 are rejected.
8. The prior arts made of record and not relied upon is considered pertinent to applicant's disclosure:



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Barlow et al. (US 6,038,551) disclose system and method for configuring and managing resources on a multi-purpose integrated circuit card using a personal computer.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571) 272-6796. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3600.

10. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

P.O. Box 1450

Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300 (for formal communication intended for entry),

or

(571) 273-0325 (for informal or draft communication, please label

"PROPOSED" or "DRAFT").

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Hand-delivered responses should be brought to Knox building, 501 Dulany  
Street, Alexandria, VA, First Floor (Receptionist).

A handwritten signature in cursive script, appearing to read "Nga Nguyen".

NGA NGUYEN  
PRIMARY EXAMINER

October 10, 2007